

REMARKS

Applicant thanks the Examiner for the thorough examination given the present application. New claim 10 has been added. Claims 1, 3-7, 9 and 10 are now present in the application. Claims 1, 3, 7 and 9 are independent.

The Office Action dated April 2, 2008 has been received and carefully reviewed. Each issue raised in the Office Action is addressed below, and reconsideration and allowance of the pending claims are respectfully requested in view of the following remarks.

Priority Under 35 U.S.C. § 119

Applicant thanks the Examiner for acknowledging Applicant's claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document, which was filed in the parent application, now U.S. Patent No. 6,728,466.

Double Patenting Rejections

In the Office Action, claims 3-6 and 9 stand rejected on the ground of non-statutory obviousness-type double patenting over claims 1-4 of U.S. Patent No. 6,728,466. This rejection is respectfully traversed. A complete discussion of the Examiner's rejection is set forth in the Office Action and is not being repeated here.

It is submitted that the double patenting rejections are misapplied for the following reasons. In the parent application, now U.S. Patent No. 6,728,466, there was a requirement for restriction made under 35 U.S.C. § 121 between two groups of claims, Group I directed to apparatus and method that uses time information recorded with messages for ordering, and

Group II directed to apparatus and method that uses key information for ordering. Group I was elected and examined and claims directed to that invention were allowed, and ultimately issued as the above noted patent. Claims directed to Group II were filed in the instant Divisional application. Reduced to its essence, what has occurred is that in the parent application the Examiner stated on the record that there were two independent and patentably distinct inventions, and then after the divisional is filed directed to the nonelected invention, the Examiner has asserted that the inventions are obvious over each other. This practice is not permitted by law.

35 U.S.C. § 121 specifically states that:

“A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, **shall not be used as a reference either in the Patent and Trademark Office** or in the courts against a divisional application or against the original application or on any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. (emphasis added)

M.P.E.P. § 804 states in part:

“a double patenting rejection **is not permitted** where the claimed subject matter is presented in a divisional application as a result of a requirement for restriction made in a parent application under 35 U.S.C. § 121. (emphasis added)

M.P.E.P. § 804.01 provides further explanation that double patenting rejections are not to be made when the divisional is filed as a result of a requirement for restriction in the parent application. Under these circumstances, 35 U.S.C. § 121 bars the use of the parent application as a reference against this application. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Claim Rejections – 35 U.S.C. § 102

Claims 1, 2, 7 and 8 stand rejected under 35 U.S.C. § 102(e) as allegedly unpatentable over U.S. Patent No. 5,696,576 to Ito et al. (“Ito”). This rejection is respectfully traversed.

With regard to the rejection of claims 1 and 7, while not conceding the appropriateness of the Examiner’s rejection, but merely to advance prosecution of the instant application, Applicant respectfully submits that independent claims 1 and 7 have been amended to include the limitations incorporated from claims 2 and 8, directed to the specific kinds of key information, but excluding the key information that includes data representing the time at which the image data representing the ordered image was recorded. Therefore, claims 1 and 7 specify that the key information consists of at least one of partial image data representing part of an ordered image, a checksum of the ordered image, and data representing a random number generated at recording of the ordered image.

Ito shows an image processing apparatus that stores ordering information related to the date and time of photographing. Ito does not show or suggest the use of at least one of partial image data representing part of an ordered image, a checksum of the ordered image, and data representing a random number generated at recording of the ordered image to verify an ordered image. Accordingly, Applicant respectfully submits that the combination of elements as set forth in independent claims 1 and 7, and new dependent claim 10, is not disclosed or made obvious by the prior art of record, including Ito, for the reasons explained above. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

All objections and rejections raised in the Office Action having been properly traversed and addressed, it is respectfully submitted that the present application is in condition for allowance. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Notice of same is earnestly solicited.

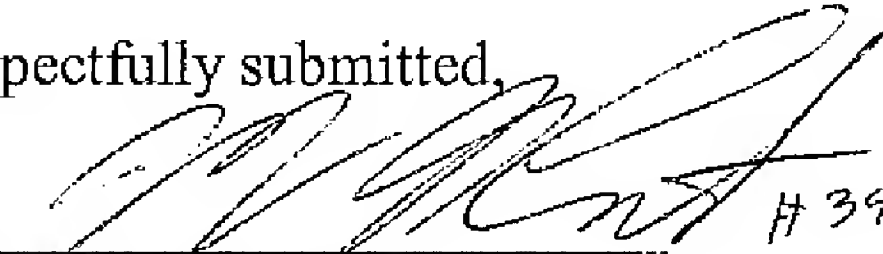
Prompt and favorable consideration of this Amendment is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Paul T. Sewell, Registration No. 61,784, at (703) 205-8000, in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.14; particularly, extension of time fees.

Dated: June 26, 2008

Respectfully submitted,

By  # 39,991
for D. Richard Anderson
Registration No.: 40,439
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant